

IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF PUERTO RICO

TAINOAPP, INC.,

Plaintiff,

v.

BARNES & NOBLE, INC.,  
BARNESANDNOBLE.COM LLC, and  
NOOK MEDIA LLC,

Defendants.

§  
§  
§  
§  
§  
§  
§  
§  
§  
§

CIVIL ACTION NO.  
3:14-cv-01212-DRD

JURY TRIAL DEMANDED

**JOINT CLAIM CONSTRUCTION AND PREHEARING STATEMENT**

In accordance with the Initial Scheduling Conference Memorandum (D.E. 23), Plaintiff TainoApp, Inc. (“TainoApp”) and Defendants Barnes & Noble, Inc., barnesandnoble.com LLC, and NOOK Media LLC (collectively “B&N” or “Defendants”) submit their Joint Claim Construction and Prehearing Statement.

**I. Agreed Constructions**

The parties do not agree on the construction for any terms.

**II. Disputed Constructions**

The parties disagree over how to construe the terms listed in the table below.

The table contains each party’s proposed construction.

Term to Construe	TainoApp’s Proposed Construction	B&N’s Proposed Construction
wherein said clock operates at a frequency providing an display update interval	wherein said clock operates at a frequency that sets the interval for altering bit status in the display processing unit	wherein the clock sets a regular pace at which updates occur for the dynamic data

Term to Construe	TainoApp's Proposed Construction	B&N's Proposed Construction
location-addressable pixels	pixels capable of being individually addressable by location	pixels that are individually addressable
said pixels capable of sustained image display without constant refreshing	said pixels capable of maintaining bit status without re-displaying the current image	the pixels can maintain an image without continuously receiving refresh signals
refreshing	Re-displaying the current image	receiving refresh signals
first area excludes at least a second area of said display screen	first portion of the display screen excludes at least a second portion of the display screen	No construction needed.
first type designated for a first specified area	first type of designated for a first portion of the display screen	dynamic type for display in a first specified area
type	category of data	dynamic type or static type
second data block of a second type different from said first data block	no construction necessary in light of the proposed construction of <i>Type</i>	second data block of a static type
third data block of [the] first type designated for [the] first specified area of [the] display screen	third data block of the first type designated for the first portions of the display screen	third data block of the dynamic type for display in the first specified area of the display screen
updating in a second update interval said first specified area of said display screen with said third data block without updating said second area of said display screen	altering the bit status in a second update interval with said first portion of the display screen with said third data block without altering the bit status of the second portion of the display screen	in the next interval following the first interval sending data signals

**I. Intrinsic Evidence**

The parties intend to use the intrinsic evidence identified below to support their respective constructions:

Term to Construe	TainoApp's Supporting Evidence	B&N's Supporting Evidence
wherein said clock operates at a frequency providing an display update interval	Specification, Column 3, lines 8-10 + Column 3, lines 51-67.	'791 patent at col. 3, lines 31-40; col. 4, lines 39-44; col. 4, lines 48-51; and Fig. 7. Response to July 14, 2004 office Action at 3. Appeal Brief at 6.
location-addressable pixels	Specification, Column 2, lines 63-64 + Column 5, lines 32-33	Plain meaning.
said pixels capable of sustained image display without constant refreshing	Specification, Column 2, lines 63-64 + Column 5, lines 32-33 + Column 3, lines 8-10	'791 patent at col. 1, lines 17-25; col. 2, lines 5-13; col. 3, lines 4-10; and col. 3, lines 51-67. RCE at 7, 11, and 12. Response to April 9, 2004 office action at 4. Response to July 14, 2004 office action at 2.
refreshing	Specification, Column 3, lines 8-10 + Column 4, 39-46	'791 patent at col. 1, lines 17-25; col. 2, lines 5-13; col. 3, lines 4-10; and col. 3, lines 51-67. RCE at 7, 11, and 12. Response to April 9, 2004 office action at 4. Response to July 14, 2004 office action at 2.

Term to Construe	TainoApp's Supporting Evidence	B&N's Supporting Evidence
first area excludes at least a second area of said display screen	Prosecution History, Brief for Appellant/Applicant of Sept. 12, 2005 at p. 9 + Prosecution History, Applicant's April 26, 2004 Supplemental Reply Responsive to the Examiner's Office Action of April 9, 2004, at 3 + Prosecution History, October 27, 2005's Brief for Appellant as to Examiner's June 17, 2005 final rejection, at 9 + Jan. 8, 2005's Reply to Examiner Office Action of December 29, 2004, at 9.	No construction needed.
first type designated for a first specified area	Prosecution History, Brief for Appellant/Applicant of Sept. 12, 2005 at p. 9 and 12.	'791 patent at col. 3, lines 31-32; col. 3, lines 38-40; col. 4, lines 39-44; col. 4, lines 49-51; and Fig. 2. Response to July 14, 2004 Office Action at 3. Response to June 17, 2005 Final Office Action at 8. Appeal Brief at 2 and 6. January 27, 2006 Notice of Allowability at 2.
type	Specification, Column 3, lines 30-39 and Figure 2	'791 patent at col. 3, lines 31-32; col. 3, lines 38-40; col. 4, lines 39-44; col. 4, lines 49-51; and Fig. 2. Response to July 14, 2004 Office Action at 3. Response to June 17, 2005 Final Office Action at 8. Appeal Brief at 2 and 6. January 27, 2006 Notice of Allowability at 2.

Term to Construe	TainoApp's Supporting Evidence	B&N's Supporting Evidence
second data block of a second type different from said first data block	Specification, Column 3, lines 30-39 and Figure 2	'791 patent at col. 3, lines 31-32; col. 3, lines 38-40; col. 4, lines 39-44; col. 4, lines 49-51; and Fig. 2. Response to July 14, 2004 Office Action at 3. Response to June 17, 2005 Final Office Action at 8. Appeal Brief at 2 and 6. January 27, 2006 Notice of Allowability at 2.
third data block of [the] first type designated for [the] first specified area of [the] display screen	Specification, Column 3, lines 30-39 and Figure 2 + Prosecution History, Brief for Appellant/Applicant of Sept. 12, 2005 at p. 9 and 12	'791 patent at col. 3, lines 31-32; col. 3, lines 38-40; col. 4, lines 39-44; col. 4, lines 49-51; and Fig. 2. Response to July 14, 2004 Office Action at 3. Response to June 17, 2005 Final Office Action at 8. Appeal Brief at 2 and 6. January 27, 2006 Notice of Allowability at 2.
updating in a second update interval said first specified area of said display screen with said third data block without updating said second area of said display screen	Specification, Column 3, lines 8-10 + Column 3, lines 51-67 + Prosecution History, Brief for Appellant/Applicant of Sept. 12, 2005 at p. 9 and 12.	'791 patent at col. 1, lines 17-25; col. 2, lines 5-13; col. 3, lines 4-10; col. 3, lines 51-67; col 4, lines 6-14; col 4, lines 39-46; col. 4, lines 48-51; col. 5, lines 50-67; and Figs. 5 and 7. RCE at 10 and 12. Response to April 9, 2004 at 2-4. Response to July 14, 2004 Office Action at 2. Response to December 29, 2004 Office Action at 9. Appeal Brief at 8.

The parties do not intend to rely on any extrinsic evidence to support their proposed constructions.

**II. Anticipated Hearing Length**

The parties expect to need a half a day for the Claim Construction Hearing.

**III. Witnesses**

The parties do not plan to call any witnesses at the Claim Construction Hearing.

**IV. Other Issues**

At this time, the parties have not identified any other issues requiring a prehearing conference.

**RESPECTFULLY SUBMITTED.**

In San Juan, Puerto Rico, this 20th day of November, 2014.

/s/Rachel M. Capoccia

Rachel M. Capoccia (admitted *Pro Hac Vice*)

**ALSTON & BIRD LLP**

333 South Hope St., 16<sup>th</sup> Floor

Los Angeles, CA 90071-3004

Phone: (213) 576-1000

Fax: (213) 576 1100

Email: rachel.capoccia@alston.com

Andrés W. López

USDC No. 215311

**THE LAW OFFICES OF ANDRÉS W.**

**LÓPEZ, P.S.C**

P.O. Box 13909

San Juan, PR 00908

Phone: (787) 294-9508

Fax: (787) 294-9519

Email: andres@awllaw.com

**ALSTON & BIRD LLP**

90 Park Avenue

New York, NY 10016

Phone: (212) 210-9400  
Fax: (212) 210-9444  
William H. Baker (admitted *Pro Hac Vice*)  
bill.baker@alston.com  
Aoife Butler (admitted *Pro Hac Vice*)  
aoife.butler@alston.com  
Leah W. Feinman (admitted *Pro Hac Vice*)  
leah.feinman@alston.com

*Attorneys for Defendants and Counter-Claim  
Plaintiffs Barnes & Noble, Inc.,  
barnesandnoble.com, LLC, and NOOK Media  
LLC*

**FERRAIUOLI LLC**  
221 Plaza, 5th Floor  
221 Ponce de León Avenue  
San Juan, PR 00917  
Tel.: 787.766.7000  
Fax: 787.766.7001

By: /s/Jean Vidal-Font  
Jean G. Vidal Font  
USDC No. 227811  
Email: jvidal@ferraiuoli.com

Eugenio J. Torres-Oyola  
USDC No. 215505  
Email: etorres@ferraiuoli.com

Cristina Arenas Solís  
USDC-PR No.223511  
carenas@ferraiuoli.com

*Attorneys For Plaintiff Tainoapp, Inc.*